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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,494	07/24/2001	Thoedore M. Wong	SP-1093.2	7897

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EXAMINER

WARE, DEBORAH K

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 07/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/912,494

Applicant(s)

Wong et al.

Examiner

Deborah Ware

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 10, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 79-86 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 79-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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Newly added claims 79-86 are presented for reconsideration on the merits.

This case is a continuation in part (CIP) of parent application 08/996,976, filed December 23, 1997, now abandoned. It is noted that the newly presented claims constitute the new matter in the instantly filed CIP of which is entitled to the benefit of the instant filing date July 24, 2001 and thus, the newly claimed subject matter does not have priority back to the date of the parent case noted above. The Preliminary Amendment filed July 24, 2001 with the filing of the instant CIP will be entered in part with respect to the new matter to be added to the specification to support the newly added claims 79-86. However, since the claims 103-105 and 92-102 as set forth in the Preliminary Amendment of July 24, 2001, in the instant case never existed the claims 106-110, also of the Preliminary Amendment of July 24, 2001, could not be entered nor could 103-105 be amended or 92-102 be canceled because they never existed in the instant case. Also claims 106-110 were dependent upon non-existent claim 103. Applicants corrective action to the claims in the amendment filed April 10, 2003 is appreciated. The pending claims for the instant application are now clear on the record.

Cancellation of claims 1-78 is acknowledged. The amendment filed April 10, 2003, is further acknowledged.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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2. Claims 83-85 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 83-85 are rendered vague and indefinite for the recitation of ", by weight" wherein it is unclear by weight of what is being claimed. It is by weight of the total composition or by weight of something else, as for example the soy protein material? A "composition comprising," as claimed herein includes many things other than soy protein material as a total composition, per se. Therefore, it is unclear what "by weight" is intended to mean. Thus, the metes and bounds of the claims can not be determined.

4. Claims 79-85 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0 380 343, cited of record in a prior action of January 27, 2003, note pages 5-6.

Claims are newly drawn to a composition comprising soy protein isolate containing low amounts of ribonucleic acid and phytic acid.

The EP patent teaches a composition comprising soy protein isolate containing low amounts of phytic acid. Note page 9, see Tables 2 and 3 wherein such low amounts of phytic acid are detected that the Tables reflect 0.0% phytic acid with increasing enzyme dosages for phytate reduction of soy protein isolate.

The claims are identical to the disclosure of the EP reference and are considered to be anticipated by the teachings therein. The specific ranges of at most 4000 mg/kg ribonucleic acids

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(RNAs), less than 2000 mg/kg RNAs, 1500 mg/kg RNAs, 0.45% or less phytic acid, 0.2% or less phytic acid and 0.1% or less phytic acid are clearly ranges which fall within the ranges disclosed by the reference (for example less than 1.1% phytic acid because Table 3 depicts 0.0 which is less than 1.1 also depicted in Table 3, hence this reads on a range of less than 1.1% phytic acid of which encompasses any percent amount such as less than 0.45% or 0.2% or 0.1%). The low amounts of RNAs are inherent to the cited disclosure because RNA is present in the soy protein, thus the claimed ranges are inherent in the soy protein isolate of the cited reference. However, in the alternative that there is some difference between the claims and the cited reference, then such difference is considered to be so slight as to render the claims *prima facie* obvious over the cited reference. It would have been obvious to one of skill in the art at the time the claimed invention was made to degrade ribonucleic acids along with phytic acid because of enzymatic activity of Finase which can degrade phytate as well as can be expected to degrade RNAs. Further, the reference does not disclose the absolute presence of ribonucleases in the composition comprising a soy isolate. Therefore, the claims are alternatively considered to be obvious over the cited reference.

5. Claims 79 and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP patent, cited above, in view of newly cited Ulrich et al., cited on the enclosed PTO-892 Form.

6. Claim 79 is discussed above, and claim 86 is further drawn to the composition as discussed above, of which contains less than 3000 ppm phosphorous.

7. EP patent is discussed above.

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8. Ulrich et al. cited, herein, teach oilseeds such as soybean wherein the phosphorous content of the seedoil is less than 3000 ppm or more specifically determined to be 365 ppm and can be expected to contain a phosphorous content of from about 600 ppm to about 800 ppm.

Note col. 6, lines 60-65 and col. 7, lines 55-58 and lines 65-66.

9. The claim differs from EP patent in that there appears to be no disclosure of phosphorous content of less than 3000 ppm in the composition.

10. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was filed to determine the phosphorous content of the composition comprising a soy protein isolate as disclosed by the EP reference and determine that the composition with a high standard of expected results that phosphorous content is less than 3000 ppm as disclosed or at least suggested by Ulrich et al. Clearly one of skill in the art would have expected successful results for determining a composition comprising oilseed or soy protein isolate to contain less than 3000 ppm phosphorous as Ulrich et al. teach the same. There is no reason to expect that the soy protein isolate or the total composition comprising a soy protein material would not contain less than 3000 ppm since Ulrich clearly discloses several ppm amounts of phosphorous of which are clearly within the range of less than 3000 ppm and that these amount are determined for compositions comprising oilseeds such as soy material. Thus, in the absence of persuasive evidence to the contrary the claims are clearly rendered prima facie obvious over the newly applied art rejection.

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11. Claims 79-85 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over newly cited Thomas et al., see enclosed PTO-892 Form.

12. Claims are discussed above.

13. Thomas et al. teach a composition comprising soy protein isolate, note col. 5, lines 4-10, that is low in phytic acid (less than 0.065%) and no more than about 0.4 mg of RNAs, note col. 6, lines 45-50, of which is clearly within the range of no more than 4000 mg/kg RNAs. Further, the reference is devoid of any teaching of ribonuclease enzymes being present in the composition. Note col. 5, lines 41-42 and col. 6, lines 1-5, 10-15 and 40-52; and 53-55. Also note col. 9, lines 1-5 and 14-15 and 19-22 and col. 10, lines 33-37, and col. 11, lines 50-55 and 60-67 and col. 12, lines 45-50 and 60-67. Phosphorous is disclosed to be present in the composition.

14. Claims are identical to the cited disclosure, and are therefore, considered to be anticipated by the teachings of the cited reference. A composition devoid of ribonuclease enzymes is inherent to the teachings of the cited reference or can at least be inferred in that the reference does not disclose the presence of any ribonuclease enzymes. However, in the alternative that the claims are different in some way or that there is some unidentified claim characteristic for which is not disclosed by the cited reference, then the difference is considered to be so slight as to render the claims prima facie obvious over the cited prior art.

15. It would have been obvious to one of ordinary skill in the art to provide for a composition substantially devoid of ribonuclease enzymes as the reference discloses that commercial grade

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pectinases are enzymes which reduce phytic acid and RNAs. Thus, one of skill would have been motivated to select for pectinases and not a ribonuclease. Clearly in the alternative the claims are at least prima facie obvious over the cited prior art. The ranges of low RNAs and phytic acid as claimed are anticipated by the cited prior art but in the alternative would have been expected to be in no more than 4000 mg/kg, less than 2000 mg/Kg, 1500 mg/kg or less than 0.45%, 0.2% and 0.1%, respectively, based upon the teachings of the cited prior art. The claims are clearly taught by the cited prior art and the composition is at least prima facie obvious over the cited reference.

16. Claims 79 and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. in view of Ulrich et al, both discussed and cited above.

17. Claims are discussed above as well

18. Claims differ from Thomas et al. in that phosphorous of less than 3000 ppm being contained within the composition is not disclosed.

19. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was filed to provide for the composition as disclosed by Thomas et al. containing less than 3000 ppm phosphorous as disclosed by Ulrich et al. Phosphorous is clearly disclosed by Thomas et al. to be contained in the composition, note col. 12, lines 60-65. Thus, it would have been an obvious modification to determine the phosphorous content to be less than 3000 ppm as Ulrich clearly discloses that less than 3000 ppm is expected. Thus, the claims are prima facie obvious over the cited prior art.



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20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

All claims fail to be patentably distinguishable over the state of the art discussed above and cited on the enclosed PTO-892 and/or PTO-1449. Therefore, the claims are properly rejected.

The remaining references listed on the enclosed PTO-892 and/or PTO-1449 are cited to further show the state of the art.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is (703) 308-4245. The examiner can normally be reached on Mondays to Fridays from 9:30AM to 6:00PM.

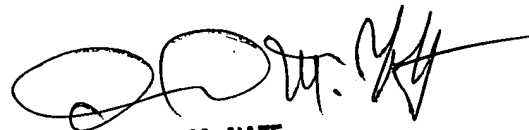
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
Deborah K. Ware

June 27, 2003

  
DAVID M. NAFF  
PRIMARY EXAMINER  
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